REMARKS

Claims 1-9, 11-23, 25-30 and 32-46 are currently pending in the application. By this Reply, Applicant has amended Claims 1, 3, 6, 8, 17, 19, 23, 30, 33 and 36. No new matter has been added by this amendment. Claims 10, 24 and 31 have been previously canceled. Claims 16, 29 and 46 have been allowed. Accordingly, Claims 1-9, 11-16, 17-23, 25-29, 30 and 32-46 are at issue.

General Remarks

On page 2 of the June 24, 2005 Office Action, the Examiner allowed Claims 16, 29 and 46. Applicant acknowledges the Examiner's allowance of those claims. Applicant also has observed that the Examiner did not, in the June 24, 2005 Office Action, reiterate his previous objections under 35 U.S.C. § 112. Those objections had been raised in the November 24, 2004 Office Action, and were addressed by Applicant in the February 23, 2005 Reply to that office action. Accordingly, Applicant therefore considers those objections withdrawn. To the extent that they are not withdrawn, Applicant's remarks made in the February 23, 2005 reply are incorporated herein by reference.

Remarks Concerning Rejections Under 35 U.S.C. § 102

On page 2 of the June 24, 2005 Office Action, the Examiner rejected Claims 1-3, 5-9, 11-13, 17-20, 22-23, 25-26, 30, 32-33 and 35-43 as being anticipated by U.S. Patent No. 6,788,980 to Johnson ("Johnson"). In light of the amendments made herein, Applicant respectfully traverses that rejection.

The present invention is drawn to a system and method for programming an application program controlling a factory automation device on a communication network. Claim 1, as amended herein, describes an exemplary embodiment, and requires that a programming device is operably connected to the network, and includes a program package, which is used to create and edit the application program, and a web page is resident on the programming device, and is

accessible to a user via a web browser to edit the application program controlling the factory automation controller. The other independent claims of the application are drawn to different embodiments, but all of the independent claims include a programming device that controls a factory automation device, wherein the programming device includes a program package that is edited via a web browser.

Johnson, by comparison, is directed to a method for control using field and control devices that provide a virtual machine environment. Johnson describes certain types of "control" devices "such as controllers, workstation, [and] servers" (col. 7, l. 62). Johnson teaches that "the devices include web server software, e.g. software of the type that serves graphical 'web' pages in response to requests by other devices." (col. 7, ll. 67 et seq.). The Examiner has stated that that disclosure in Johnson anticipates the claims of the present invention, and specifically the limitation in the present claims for "at least one web page resident on the programming device and operably connected to the program package". The disclosure in Johnson, however, fails to anticipate the claims of the present application for two reasons.

First, Johnson fails to disclose a web page resident in the *programming device*. The claims of the present application make clear that there is a programming device, and that there is a web page resident in the programming device. Johnson teaches that "the devices include web server software", but Johnson fails to specify which devices include that software. From reading Johnson, there is no way to know whether Johnson intends the web server software to reside on a network terminal used to program a factory device. Quite to the contrary, it is a reasonable interpretation of Johnson that there are both workstations (i.e., programming devices) and servers on the network (col. 7, l. 62), and that the web server software resides only on the server, and not on the workstation. That reading of Johnson is at least as persuasive as the Examiner's interpretation in light of Johnson's disclosure that the web server serves pages "in response to requests by *other devices*" (col. 8, l. 2, emphasis added). The only other types of device described by Johnson are controllers and workstations, which are far more analogous to the "programming device" of the present application than Johnson's server. In short, while Johnson teaches a web page resident on a device of some type, Johnson does not disclose that the web

page is resident on the *programming* device. The Examiner has concluded that the web server resides on a programming device in Johnson, but that disclosure in Johnson is never made.

Second, Johnson does not disclose that the web page is "operably connected to the program package". The present claimed system requires that the programming device is used to control a factory automation device using a programming package, and that the programming device includes a web page *operably connected to the program package.* In other words, it is the web page of the present invention that allows the user to use the program package to edit the application program controlling the factory device. Johnson fails to disclose that feature. Johnson teaches merely that there is a web server on the network that serves web pages in response to a request from another device. That disclosure does not teach or suggest that the web server serves pages that are operably connected to a program package used to edit a control application for controlling a factory device.

In sum, Johnson does not disclose two key elements of the claims of the present application. Johnson does not disclose a web page resident in the programming device, and does not disclose that the web page is operably connected to the program package. Therefore, Johnson does not anticipate the claims of the present application.

Moreover, the pending independent claims of the present application have been amended herein, and those amendments provide further elements not disclosed by Johnson. Claims 1, 8, 23 and 36 have all been amended to clarify that the programming device is remotely located from the factory automation device. Johnson does not teach or suggest that element. Additionally, Claims 1, 3, 6, 8, 17, 30 and 33 have all been amended to clarify that the factory automation device is graphically depicted in the web page. Johnson does not teach or suggest that element either. In short, the independent claims of the present application (that have not been allowed) have all been amended to include additional elements not disclosed by Johnson. In light of those amendments, Applicant respectfully submits that independent Claims 1, 3, 6, 8, 17, 19, 23, 30, 33 and 36 are not anticipated by Johnson, and respectfully requests that the § 102 rejection based on that reference be withdrawn.

Claims 2, 4, 5, 7, 9, 11, 12 and 13 are all dependent on Claim 1, which as described herein is patentably distinct over Johnson. Those independent claims include the limitations of

Claim 1, and are therefore patentably distinct over Johnson for the same reasons. Likewise, Claims 18, 20, 22, 25 and 26 are dependent on Claim 17, and Claims 32, 35 and 37-43 are dependent on Claim 30. Both Claims 17 and 30 have been herein amended to include limitations that are not disclosed by Johnson. Therefore, Applicant respectfully submits that Claims 2, 4, 5, 7, 9, 11, 12, 13, 18, 20, 22, 25, 26, 32, 25 and 37-43 of the present application are also patentably distinct over Johnson, and requests that the rejection of those claims be withdrawn as well.

Remarks Concerning Rejections Under 35 U.S.C. § 103

On page 2 of the June 24, 2005 Office Action, the Examiner rejected Claims 4, 14-15, 21, 27-28, 34 and 44-45 as being invalid over Johnson in view of U.S. Patent No. 6,038,486 to Saitoh et al. ("Saitoh"). In light of the amendments made herein, Applicant respectfully traverses that rejection.

As noted above, Johnson does not disclose four elements of the present claims: a web page resident in a programming device, a web page operably connected to a program package, a programming device remotely located from the factory automation device, or a factory automation device graphically depicted in a web page. Saitoh fails to cure these deficiencies of Johnson.

Saitoh is directed to a method of operating, controlling, monitoring and analyzing data of control devices. The system described by Saitoh reads data from files, wherein each type of device on the network has a different file type. An "inspection machine" at a factory analyzes data in the files, and reports that data to users via a network. Saitoh does disclose that one option for reporting the data via the network is through a web page (col. 4, ll. 23-34). However, Saitoh does not disclose that the web page is operably connected to a program package for editing a control application controlling a factory automation device. Saitoh's web page is for monitoring only. According to Saitoh, a factory server inspects the factory equipment, and a web page is generated for displaying the results of the inspection. Unlike the claimed invention, Saitoh's web page cannot be used to edit the control application; it can be used only for viewing the results of a factory inspection. Saitoh's only use of the web page for input from the user is for uploading a

parameter file (col. 5, ll. 5-14), not for editing a control application. In short, Saitoh does not disclose a web page for editing a control application.

Moreover, Saitoh does not teach or suggest the graphical depiction of a factory automation device in a web page. Saitoh's web page is generated by converting a "raw" data file to a file that can be viewed through a web browser (col. 4, ll. 23-34). Saitoh does not disclose that in the web page, the factory automation device is graphically depicted. (In fact, Saitoh does not disclose any depiction, graphical or otherwise, of the factory automation device.)

In sum, neither Johnson nor Saitoh, nor the combination thereof, teaches or suggests a web page operably connected to a control program or the graphical depiction of a factory automation device in a web page. Independent Claims 1, 17 and 30 of the present application include both of those elements, and are therefore patentable over the combination of Johnson and Saitoh. Dependent Claims 4, 14-15, Claims 21, 27-28 and Claims 34, 44-45 are dependent on Claims 1, 17 and 30, respectively, and therefore include the elements of Claims 1, 17 and 30 respectively. Because Johnson and Saitoh do not disclose all of the limitations of those independent claims, they do not disclose the limitations of the dependent claims either. Applicant respectfully submits that all of the claims of the present application are thus patentable over Johnson and Saitoh, and requests that the § 103 rejection based on those references be withdrawn.

Furthermore, Applicant respectfully maintains that the combination of Johnson and Saitoh is improper because there is no motivation or incentive in the prior art to combine those references in the manner suggested by the Examiner. See *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1785 (Fed. Cir. 1995). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where a teaching, suggestion or motivation to do so is found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combinations and a reasonable expectation of success of that combination must both be found in the prior art, not in the

applicant's disclosure, *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness, MPEP § 2142. In the present case, the Examiner has failed to meet that burden. Instead, the Examiner has simply concluded that one skilled in the art would make the suggested modification. That is insufficient.

The Examiner has opined that there is an incentive to combine the Johnson and Saitoh references because the combination would "increase the overall system usefulness by allowing the programming of a factory control system from any location without requiring special software for file transfers" (p. 21, November 24, 2004 Office Action). That incentive, however, is not found anywhere in the references themselves, nor do either of the references disclose how their combination would be at all achieved, or even possible. The conclusion that any combination of Johnson and Saitoh would have been obvious is therefore a hindsight determination, which is an improper foundation upon which to combine references.

Hindsight combination of references, using the present invention as a roadmap, is improper. It is well recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed invention obvious, *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Applicant therefore respectfully submits that in addition to failing to disclose all of the elements of the claims of the present application, the combination of Johnson and Saitoh is improper, and requests that the § 103 rejection based on those references be withdrawn.

CONCLUSION

In light of the remarks and amendments made herein, Applicant respectfully submits that Claims 1-9, 11-15, 17-23, 25-28, 30 and 32-45 are in condition for allowance. Applicant notes that claims 16, 29 and 46 have already been allowed. Applicant respectfully requests that the Examiner withdraw the rejections and allow the claims to issue. If it may be of assistance to contact the undersigned Attorney regarding the present invention, the Examiner is invited to do

so. The Commissioner is hereby authorized to charge Deposit Account No. 23-0280 in connection with any fees associated herewith.

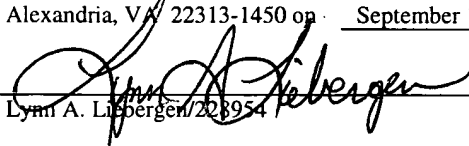Respectfully submitted,

Dated: September 1, 2005   By: _____

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Lynn A. Lipberger/22954